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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,582	09/16/2003	Michael Knowles	555255012416	3293
33070	7590	06/17/2005	EXAMINER	
JOSEPH M. SAUER JONES DAY REAVIS & POGUE NORTH POINT, 901 LAKESIDE AVENUE CLEVELAND, OH 44114			GARY, ERIKA A	
			ART UNIT	PAPER NUMBER
			2681	

DATE MAILED: 06/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/663,582

Applicant(s)

KNOWLES, MICHAEL

Examiner

Erika A. Gary

Art Unit

2681

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/16/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9/13/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 2, 4, 7, and 9-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Yang et al., US Patent Application Publication Number 2003/0065738 (hereinafter Yang).

Regarding claim 1, Yang discloses a system for updating service information in a mobile communication device, comprising: a provisioning server operable to receive service information for the mobile communication device from at least one of a plurality of service providers and store the service information in a service update database; the provisioning server being further operable to receive a provisioning update request from the mobile communication device and in response to the provisioning update request determine if the stored service information has previously been transmitted to the mobile communication device, and if the stored service information has not previously been transmitted to the mobile communication device, then encapsulate the service information in a service update data message and transmit the service update data message to the mobile communication device; wherein the mobile communication

device is operable to detect a triggering event and transmit the provisioning update request to the provisioning server in response to the triggering event [fig. 2; paragraphs 0041-0047].

Regarding claim 2, Yang discloses the provisioning update request transmitted by the mobile communication device identifies at least one of the plurality of service providers, and wherein the service update data message transmitted to the mobile communication device from the provisioning sever includes service information from the identified service provider [paragraph 0066].

Regarding claim 4, Yang discloses wherein the service update database is operable to store update information that identifies service information that has been transmitted to the mobile communication device, and wherein the provisioning server is operable to determine from the update information whether the service information from the identified service provider has already been transmitted to the mobile communication device, and if the service information from the identified service provider has already been transmitted to the mobile communication device, then not transmitting the service information in response to the provisioning update request [paragraph 0045].

Regarding claim 7, Yang discloses the triggering event is a user request [paragraph 0043].

Regarding claim 9, Yang discloses the plurality of service providers includes a wireless messaging service [paragraph 0041].

Regarding claim 10, Yang discloses a method for providing demand-based provisioning to a mobile communication device, comprising: receiving service information for the mobile communication device from at least one of a plurality of service providers; storing the service information in a memory device; receiving a provisioning update request from the mobile communication device in response to a triggering event; determining if the stored service information has previously been transmitted to the mobile communication device; and if the stored service information has not previously been transmitted to the mobile communication device, then encapsulating the service information in a service update data message and transmitting the service update data message over a wireless network to the mobile communication device [fig. 2; paragraphs 0041-0047].

Regarding claim 11, Yang discloses identifying one or more of the plurality of service providers in the provisioning update request; determining if the stored service information was received from the identified service provider; and transmitting the service update data message over the wireless network to the mobile communication device if the stored information was received from the identified service provider [paragraph 0066].

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 5, 6, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yang in view of applicant's submission of prior art, Hronek, US Patent Application Number 6,564,055 (hereinafter Hronek).

Claims 5, 6, and 8 depend on claim 1. As discussed above, Yang discloses the limitation of claim 1. What Yang does not specifically disclose is the specific triggering events of claims 5, 6, and 8. However, Hronek teaches these limitations.

Regarding claims 5 and 6, Hronek discloses over the air programming of a mobile communication device wherein a triggering event may be detected by any suitable function of the wireless network (failure between the mobile communication device and the provisioning server or service provider) [col. 5: lines 25-26].

Regarding claim 8, Hronek discloses the triggering event is generated when the mobile communication device roams to a new wireless network [col. 5: lines 13-34].

Yang and Hronek are combinable because they are from the same field of endeavor, that is, over the air programming of mobile communication devices. At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify Yang to include Hronek in order to include automated triggering of an update that does not require user intervention.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Art Unit: 2681

Daly, US Patent Number 6,122,503, discloses a method and apparatus for over the air programming of telecommunication services.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erika A. Gary whose telephone number is 571-272-7841. The examiner can normally be reached on Monday-Thursday and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on 571-272-4090. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

EAG
June 14, 2005


ERIKA A. GARY
PRIMARY EXAMINER